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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,258	06/19/2001	Takashi Nishioka	209989US0	9566

22850 7590 12/26/2002

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1755 JEFFERSON DAVIS HIGHWAY  
ARLINGTON, VA 22202

EXAMINER

THORNTON, YVETTE C

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 12/26/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n N .

09/883,258

Applicant(s)

NISHIOKA ET AL.

Examiner

Yvette C. Thornton

Art Unit

1752

-- The MAILING DATE of this c mmunication appears on the cover sheet with the c rrespondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 3-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,14 and 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3-4. 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

This is written in reference to application number 09/883258 filed on June 19, 2001 and published as US 2002/0018958 A1 on February 14, 2002.

#### *Election/Restrictions*

1. Applicant's election with traverse of claims 1-2 and 14-15 in Paper No. 6 is acknowledged. The traversal is on the ground(s) that the laminated body of group II is made by the process of Group III, and as such these groups should not be separated. In addition, the polymeric material of group I is a component of the printing plate of Group IV and therefore these groups should not be separated. This is not found persuasive because groups I-V are distinct for the reasons set forth in the previous action and has acquired separate status in the art.
2. Applicants argue that the examiner has not provided sufficient reasons and/or examples to support the assertion that group I and II are related as combination/sub-combination. Group I pertains to a polymeric material which is a subcombination of group II which pertains to a laminated body. The subcombination has separate utility such as in the construction of images or semiconductors. Kubota (US 6268558 B1) teaches the use of a buffer adhesive layer comprising a thermosetting resin and an organic peroxide (c. 13, l. 37-40). This alone is support for the subcombination having a separate utility than the combination.
3. Applicants further argue the examiner has failed to meet the requirement to sustain that groups I and III and I and IV are related as product and process of use. Again the

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Examiner refers to the teachings of Kubota, which teaches a completely different process for using a composition similar to that claimed in group I.

4. The examiner withdraws the restriction requirement between groups II and III.
5. Applicants further argue that there is no evidence on the record to establish that the intermediate products of groups II and V are useful as suggested. The MPEP establishes that the "examiner must give an example of an alternative use but need not provide documentation. Applicant then has the burden to prove or provide a convincing argument that the intermediate does not have the suggested use." (see MPEP 806.04(b)) Applicant has provided no evidence that the intermediate does not function as suggested by the examiner.
6. The examiner reserves the right to rejoin the process claims if the product claims are found to be allowable.
7. The restriction requirement is still deemed proper and is therefore made FINAL.

#### *Information Disclosure Statement*

8. The Information Disclosure Statements filed on June 19, 2001 and March 29, 2002 have been entered and fully considered.

#### *Specification*

9. The abstract of the disclosure is objected to because the abstract is too long. The abstract is required to be 150 words or less. Correction is required. See MPEP § 608.01(b).

#### *Notice*

10. The examiner has interpreted the term "ethylene unit" in the instant claims to be a unit of  $\text{CH}_2=\text{CH}_2$  having no substitution. This interpretation is supported by the examples presented in the instant specification.

11. Claims 1-2 and 14-15 contain intended use language. Intended use recitations and other types of functional language cannot be entirely disregarded. However, in apparatus, article, and composition claims, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. In re Casey, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); In re Otto, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963).(MPEP 2111.02)

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

13. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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14. Claims 1-2 and 14-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Chaudhary et al. (US 6325956 B2). Chaudhary exemplifies comparative samples A-C wherein an ethylene/octene copolymer was admixed with dicumyl peroxide. The sample was mixed for 5 minutes, removed and placed in a press where the peroxide reacted to crosslink the polymer. It is the examiner's position that the taught copolymer would have at least 50% ethylene (c. 28, l. 65-c. 29, l. 25). Comparative sample F exemplifies an ethylene/octene copolymer admixed with azodicarboamide blowing agent, zinc oxide blowing agent and dicumyl peroxide (c. 31, l. 47-c. 32, l. 3). It is the examiner's position that the taught blowing agents meet the limitations of the claimed foaming agents. Chaudhary further teaches a procedure for making foam for comparative sample F (c. 32, l. 60-c. 33, l. 35).

### *Conclusion*

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Chaudhary et al. (US 2001/0002075 B1) which is the published equivalent of US 6325956 B2.
- Koffler et al. (US 2002/0120024 A1) pertaining to foam cushion and method of making and using the same.
- Ho et al. (US 2002/0049269 A1) pertaining to methods for making washable, dryable elastic articles.
- Subramonian et al. (US 2002/0006976 A1) pertaining to the preparation of a macrocellular acoustic foam.
- Kubota (US 6268558 B1) pertaining to solar battery modules.
- Parikh et al. (US 6005053 A) pertaining to polyolefin elastomer blends exhibiting improved properties.

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- Cushner et al. (US 5804353 A) pertaining to lasers engravable multilayer flexographic printing element.
- Sumi et al. (US 5202193 A) pertaining to N-substituted acrylamide copolymers.
- Higuchi et al. (US 5091586 A) pertaining to novel dialkyl peroxides, production method and use thereof.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvette C. Thornton whose telephone number is 703-305-0589. The examiner can normally be reached on Monday-Thursday 8-6:30.

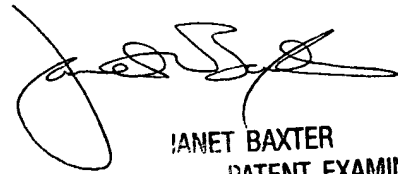
17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet C. Baxter can be reached on 703-308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

18. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1193.

**\*\*Please note that the examiner has recently changed her name from "Clarke" to "Thornton".\*\***

yct

December 19, 2002



JANET BAXTER  
PATENT EXAMINER  
CENTER 1700